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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,903	03/31/2000	CHRISTINE DUPUIS	05725.0532	7762

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 09/08/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/485,903	DUPUIS ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Lauren Q Wells	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 August 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 18-26,28-36 and 40-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 18-26,28-36 and 40-48 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>25</u> . | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 18-26, 28-36 and 40-48 are pending. The Amendment filed 8/7/03, Paper No. 24, amended claims 34, 41, and 44.

#### *Response to Applicant's Arguments/Amendment*

The Applicant's arguments filed 8/7/03 (Paper No. 24) to the rejection of claims 18-26, 28-36, 40-48 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

Applicant's amendment to the claims filed 8/7/03 (Paper No. 24) is sufficient to overcome the 35 USC 112 rejections in the previous Office Action.

#### *103 Rejection Maintained*

The rejection of claims 18-21, 24-26, 28-32, 35, 36, 40-48 under 35 U.S.C. 103(a) as being unpatentable over Feder et al. (5,721,026) in view of Dubief et al. (6,024,946) is MAINTAINED for the reasons set forth in the Office Action mailed 4/7/03, Paper No. 22, and those found below.

Applicant argues, "the Examiner has not pointed to any evidence in the references demonstrating a motivation or desirability to modify the composition of Feder to include the recited amount of the at least one non-aminated silicone alpha, omega-disilanol. . .For instance, Feder and Dubief disclose different forms of siloxanes such that there would have been no motivation to modify the siloxane teachings of Feder with the siloxane teachings of Dubief". This argument is not persuasive. First, it is respectfully pointed out that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. Second, it is

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respectfully pointed out that Feder et al. teach an emulsion comprising an alpha, omega-disilanol, an aqueous dispersion comprising insoluble polymer particle, and a cosmetically acceptable carrier. Feder et al. additionally teach their composition for use in cosmetology and specifically for hair care. Dubief et al. teach an emulsion comprising an alpha, omega-disilanol, an aqueous dispersion comprising insoluble polymer particles, and a cosmetically acceptable carrier. Dubief additionally teaches his composition for hair care. Thus, since Feder et al. does not specifically recite the amount of alpha, omega-disilanol in their composition, one of skill in the art would be motivated to look to the teachings of Dubief et al., who teach similar hair care formulations, to ascertain a cosmetically acceptable amount of alpha, omega-disilanol to add to hair care formulations.

Applicant argues, "Dubief fails to disclose or suggest that its siloxanes are in emulsion". This argument is not persuasive for two reasons. First, even if Dubief does not teach siloxanes in emulsions, one of skill would still look to Dubief to ascertain the amount of alpha, omega-disilanol to add to hair care compositions additionally comprising dispersion of insoluble polymer particles and cosmetically acceptable carriers. Second, the Examiner respectfully directs Application to Example 7 in Col. 9 of Dubief, which teaches the alpha, omega disilanol in composition with an emulsion.

Applicant argues, "The Examiner, however, cannot base a determination of obviousness on what the skilled person might try or find obvious to try". This argument is not persuasive. The Examiner respectfully points out that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the

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pertinent art. In the instant case, there is motivation for one of skill to look to the teachings of Dubief for the amount of alpha, omega disilanol in the composition of Feder et al.

Applicant argues, "However, her analysis indicates only that Dubief's compositions may contain, among other things, 'propellants.' . . . Moreover, the Examiner conveniently ignores that there is more than one definition for the broad term 'propellant' . . . Further, there is absolutely no evidence of record that proves that disclosing a 'propellant' necessitates having a 'container' to put it in". This argument is not persuasive. First, the Examiner respectfully points out that it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). Thus, it is respectfully pointed out that Dubief teach propellants as customary additives in hair care formulations. Furthermore, the Examiner respectfully points out that the meaning of the term "propellant" in the cosmetic art is accurately depicted by the Webster's Dictionary definition in the previous Office Action, and it is further respectfully pointed out that the Examiner did not conveniently exclude any definitions, but relied upon the definition that is well established in the cosmetic art. Regarding Applicant's assertions of an explosive charge or rocket fuel, it is respectfully pointed out that this is outside of the cosmetically acceptable definition of propellant. Lastly, the Examiner respectfully points out, that as defined by Webster's dictionary and as defined in the cosmetic art, a propellant must be kept under pressure in a bottle or can.

Applicant argues, "all that the Examiner has done is merely assert that the prior art teaches the same components as instantly claimed, which hardly counts as a factual and technical group for establishing inherency. For instance, the Examiner has not shown that the prior art necessarily teaches the instantly claimed cosmetic composition in the form of an aerosol". This argument is not persuasive. See the above paragraph.

The rejection of claims 33-34 under 35 U.S.C. 103(a) as being unpatentable over Feder et al. (5,721,026) in view of Dubief et al. (6,024,946), as applied to claims 18-21, 24-26, 28-32, 35, 36, 40-48, above, and further in view of Blankenburg et al. (6,153,179) is MAINTAINED for the reasons set forth in the Office Action mailed 4/7/03, Paper No. 22, and those found below.

Applicant argues, "the Examiner has failed to provide any evidence showing a reasonable expectation of success in making the claimed aerosol. . .leaving the reader to try to figure out the Examiner's rationalization". This argument is not persuasive. It is respectfully pointed out that Blankenburg et al. is relied upon to teach cosmetically acceptable propellants for use in hair care formulations. Thus, as stated in the previous Office Actions, one of skill in the cosmetic art would be motivated to look to Blankenburg for teachings of cosmetically acceptable propellants, since the combined references teach their compositions as comprising propellants, but do not teach the specific propellants.

The rejection of claims 22-23 under 35 U.S.C. 103(a) as being unpatentable over Feder et al. (5,721,026) in view of Dubief et al. (6,024,946), as applied to claims 18-21, 24-26, 28-32, 35, 36, 40-45, above, and further in view of Audousset et al. (6,106,577) is MAINTAINED for the reasons set forth in the Office Action mailed 4/7/03, Paper No. 22, and those found below.

Applicant argues, “the Examiner has not shown any evidence, much less substantial evidence, that demonstrates a suggestion, motivation, or desirability to modify the combined teachings of Feder and Dubief with the polymer particles of Audousset”. This argument is not persuasive, as the previous Office Action provides strong motivation for including the specific polymer particles of Audousset into the dispersion/in substitution for the organic copolymer of the combined references.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw

  
\_\_\_\_\_  
SREENI PADMANABHAN  
PRIMARY EXAMINER  
9/8/05